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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,042	12/06/1999	ROBERT F. BONNER	15280-347100	5889

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EXAMINER

GABEL, GAILENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/456,042

Applicant(s)

BONNER ET AL.

Examiner

Gailene R. Gabel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/3/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Amendment Entry***

1. Applicant's amendment and response filed 12/14/02 in Paper No. 14 is acknowledged and has been entered. Claims 1, 3, and 5-15 have been amended. Currently, claims 1-46 are pending. Claims 1-15 are under examination.

### **Rejections Withdrawn**

#### ***Claim Rejections - 35 USC § 102 / ODP***

2. In light of Applicant's amendment and argument, the rejection of claims 1-15 under 35 U.S.C. 102(e) as being anticipated by Goldstein et al. (US 6,100,051) is hereby, withdrawn.

3. In light of Applicant's submission of a terminal disclaimer, the rejection of claims 1-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8-11, and 15-20 of U.S. Patent No. 6,420,132, is hereby, withdrawn.

4. In light of Applicant's submission of 37 CFR §131 to establish due diligence between Applicant's conception of the invention (12/1997 to 7/1998) and the constructive reduction to practice (7/1998), the rejection of claims 1-15 under 35 U.S.C. 102(e) as being anticipated by Baer et al. (US 5,985,085) is hereby, withdrawn.

**Rejections Maintained**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because in lines 5-6, it is unclear how the “the extremity becomes adhesive to a portion of the specimen upon selective activation” without necessarily causing the selectively activatable to contact the specimen.

Claim 1, lines 13-14 is ambiguous in reciting, “separating the selectively activatable layer from the specimen to microdissect the portion of the specimen from the remainder of the specimen “ because it fails to distinctly and clearly define what portion of the specimen is microdissected. Perhaps, Applicant intends “to microdissect the contacted portion of the specimen from the remainder of the specimen after selective activation.”

Claim 3, line 3, is vague and indefinite in reciting, “visualizing the portion of the specimen to locate the portion of the specimen for microdissection” because it is unclear at what point in claim 1 from which it depends this step of visualizing is performed. It appears that the step of “visualizing” is necessarily performed before the step of “placing ... and overlaying the selectively activatable layer to a finite distance” from the specimen” in claim 1; however, it is not clearly and distinctly defined as such.

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Claim 5 remains confusing because it is unclear at what point in claim 1 from which it depends the step of “placing the coating on one side of the selectively activatable layer” is performed. It appears that the step of “placing the coating” is necessarily performed before the step of “placing ... and overlaying the selectively activatable layer to a finite distance” from the specimen” in claim 1; however, it is not clearly and distinctly defined as such.

Claim 5 is confusing and appears redundant in relation to claim 1 in reciting, “exposing the selectively activatable layer at the coating to the specimen” because it is unclear at what point in claim 1 from which it depends the step of “exposing the selectively activatable layer at the coating to the specimen” is performed. It is specifically unclear how this instant step relates functionally to the step of “placing ... and overlaying the selectively activatable layer to a finite distance from the specimen” in claim 1. Perhaps Applicant intends, “wherein the selectively activatable layer is provided with a coating on one side of the layer, the coating having an affinity specific bond with the specimen, wherein upon activation, the coated selectively activatable layer is contacted to the specimen to form affinity specific bonds with the at least one portion of the specimen.”

Claim 5 is further confusing and appears redundant in relation to claim 1 in reciting, “activating the selectively activatable layer to cause the coating having the having the affinity specific bond to contact the specimen ... with at least one part of the specimen” because it is unclear at what point in claim 1 from which it depends this step of “activating the selectively activatable layer to cause the coating having the having the

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affinity specific bond to contact the specimen ... with at least one part of the specimen” is performed. It is specifically unclear how this step relates cooperatively, structurally, and functionally to the step of “selectively activating the selectively activatable layer to cause a volumetric expansion ... to locally contact a portion of the specimen ... and become adhesive to the portion of the specimen” in claim 1. For example, does the “coating having the affinity specific bond” cause the selectively activatable layer in claim 1 to become adhesive. Further, how does the “at least one part of the specimen” relate to the “portion of specimen” recited in claim 1 from which it depends.

Claim 7 lacks antecedent support in reciting, “the series of portions on the activatable layer”. Perhaps, Applicant intends, “the series of portions of the specimen on the activatable layer.”

Claim 8 is vague and indefinite in reciting, “adhesive properties” because it is unclear what is encompassed by the term, “properties”, i.e. affinity bonding, chemical compound capable of adhesion, adhesive tape.

In claim 8, after “allowing the heated”, “the” should be deleted.

Claim 9 is confusing and appears redundant in relation to claim 8 in reciting, “allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ...” because it is unclear how this step relates cooperatively, structurally, and functionally to the step of “allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ...” in claim 8 since it is being claimed as a separate method step. Please clarify.

Claim 10 is indefinite and appears redundant in relation to claim 8 from which it depends in reciting, “contracting the volumetric expansion by cooling while maintaining attachment ... to elastically tension the volumetric expansion” because it appears that the “allowing the heated selectively activatable layer to cool and elastically contract” in claim 8 already contracts the selectively activatable layer. Therefore, it is unclear what structural and functional cooperative relationship exists between these equivalent steps in claims 8 and 10.

Claim 10 is confusing in relation to claim 9 which also depends from claim 8 because in claim 10, the activatable layer is “withdrawn” to separate the (targeted) portion of the specimen from the remainder of the specimen; however, in claim 9, the volumetric expansion is only “cooled and elastically contracts” to effect microdissection of the portion. Please clarify.

Claim 11 is vague and indefinite in relation to claim 8 in reciting, “contracting the volumetric expansion at the extremity to withdraw the portion of the specimen bonded to the volumetric expansion” because it is unclear at what point in claim 8 from which it depends the step of “contracting the volumetric expansion at the extremity to withdraw the portion of the specimen bonded to the volumetric expansion” is performed. It is specifically unclear how this instant step relates structurally, functionally, and cooperatively, to the step of “allowing the heated selectively activatable layer to cool and elastically contract the extremity towards the activatable layer ...” in claim 8 since it is being claimed as a separate method step. Please clarify.

Claim 12 is vague and indefinite in relation to claim 8 in reciting, "providing activatable layer with volume change associated with phase transition" because it is unclear at what point in claim 8 from which it depends the step of "providing activatable layer with volume change associated with phase transition" is performed. It is specifically unclear how this instant step relates structurally, functionally, and cooperatively, to the step of "providing a selectively activatable layer..." in claim 8 since it is being claimed as a separate method step. Perhaps Applicant intends "wherein the activatable layer is provided with volume change ...".

Claim 14 is ambiguous in reciting "which upon activation by laser causes volumetric expansion upon heating and adhesion to a specimen" because it is unclear how "adhesion to a specimen" causes volumetric expansion.

In sum, it is noted that the dependent claims in the claimed invention, which intend to recite further limitations are replete with what appears to be redundant recitations of method steps that have already been recited in the independent or base claims. These redundancies have rendered the claims vague, indefinite, and confusing because they are read as separate method steps that complement those that are already recited in the base claims. Alternatively, if the dependent claims are intended to encompass separate and distinct method steps from those set forth in the base claims, it is suggested but not required, for clarity, definiteness, and consistency, that the recited method steps in the dependent claims make reference to when a further method



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step is effected or performed in relation to the method steps already set forth in the base claims.

***Allowable Subject Matter***

6. Claims 1-15 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday to Thursday, 6:30 AM - 4:00 PM and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 308-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Gailene R. Gabel

Patent Examiner

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February 8, 2003

*grg*

*Christopher L. Chin*

CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800/641

2/8/03